

REMARKS

I Disposition of Claims

Claims 9, 10, 12-22, and 39-49 are currently pending. Claim 9 is currently amended. Support for the amended claim can be found throughout the specification, for example in the original claims and on page 5, line 21, to page 7, line 10. No new matter has been added.

II Non-obviousness

The Examiner has rejected Claims 9, 10, 12-17, 22 and 39-49 under 35 USC 103(a) as being obvious in view of Fukuo (US 6,203,910). The Examiner asserts that Fukuo discloses, as Comparative Example 1, a mixture consisting of "ethylene glycol monobutyl ether" and "dipropylene glycol monomethyl ether." The Examiner asserts that this disclosure would make use of solvents that are "homologues" of these substances obvious.

However, the Examiner's position is improper. In order to establish a *prima facie* case of obviousness, the prior art reference must teach or suggest all the claim limitations. *See* MPEP 2143. Neither Comparative Example 1 nor any other portion of the Fukuo reference suggests the combination of solvents recited in the presently pending claims.

Fukuo in no way suggests any combination of solvents other than the combination of propylene glycol monomethyl ether and dipropylene glycol monomethyl ether. Comparative Example 1 of Fukuo discloses that "[t]he same procedure as in Example 4 was carried out with the exception of using ethylene glycol monobutyl ether in place of the propylene glycol monomethyl ether and dipropylene glycol monomethyl ether used in Example 4 as the organic solvent, thereby producing a solid product." In other words, in Comparative Example 1, rather than the combination of propylene glycol monomethyl ether and dipropylene glycol monomethyl ether used in Example 4, ethylene glycol monobutyl ether alone was used. Thus Comparative Example 1 does not disclose a combination of solvents, and nothing in Fukuo even suggests the use of a combination of solvents that includes dipropylene glycol monomethyl ether.

Both Fukuo's Comparative Example 1 and Comparative Example 7 of the present application use the same solvent, i.e. ethylene glycol monobutyl ether alone. The toxicity of the ethylene glycol monobutyl ether was rated as "C" in Table 1 of Fukuo and as "X" in Table 2 of the present specification. Both of these indications show the ethylene glycol monobutyl ether as toxic, consistent with both comparative examples representing the same solvent.

On the other hand, if the mixture used in Comparative Example 1 of Fukuo had consisted of "ethylene glycol monobutyl ether" and "dipropylene glycol monomethyl ether" in combination, a toxicity rating of "C" would not have been obtained. In Example 5 of the present specification, this combination of solvents was rated as "o", i.e. acceptable. Thus, based on the plain language of Comparative Example 5 and consistent with the toxicity profiles of the solvents obtained, it is clear that Comparative Example 1 of Fukuo discloses only the use of ethylene glycol monobutyl ether alone.

For these same reasons, Comparative Example 2 of Fukuo discloses the use of ethylene glycol monomethyl ether alone. Thus, Fukuo merely discloses the use of ethylene glycol monobutyl ether alone or ethylene glycol monomethyl ether alone. Accordingly, Fukuo does not disclose or even suggest the specific combination of solvents recited in the presently pending claims.

The Examiner based the conclusion that combinations including "homologous" compounds would be obvious on the presence of the combination of solvents in Fukuo. Since Fukuo does not actually teach such combinations, the "homologous" combinations cannot be obvious.

Moreover, the advantages of the recited combination clearly support the patentability of these claims. In particular, the wet-face writing properties of the compositions obtained using these solvents have been previously described by Applicants.

For all of these reasons, the rejection should be withdrawn and the claims allowed. the rejection should be withdrawn and the Claims allowed.

III Compliance with 35 USC 112, 2nd paragraph

The Examiner has rejected Claim 10 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Examiner has pointed out that Claim 10 recited "dipropylene glycol monomethyl ether" which had been removed from Claim 9. As Claim 9 has been amended to include this compound, Claim 10 should no longer be considered indefinite, and the claim should be allowed.

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CONCLUSION

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of all outstanding rejections are respectfully requested. Allowance of the claims at an early date is solicited. If any points remain that can be resolved by telephone, the Examiner is invited to contact the undersigned at the below-given telephone number.

Respectfully submitted,

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AMEND

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